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09/228,325	01/11/1999	LARRY STEVENS	1002.2.72	8737

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EXAMINER

CHAMBERS, MICHAEL S

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/228,325

Applicant(s)

STEVENS, LARRY

Examiner

Mike Chambers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-18 and 44-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-18 and 44-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 45 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The acrylic backboard is already claimed in claim 44.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 46 - 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Although the claims 46 and 48 have the term "catalyzed polymeric adhesive", the specification fails to mention or define this term or to show what the meets and bounds of the term is.

Claim 47 inherits the deficiency of claim 46.

Claim 49 inherits the deficiency of claim 48.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,5,6, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Chung, Hankele and Skedleski et al and Dow Q3-6093. Applicant has stated that the use of double sided adhesive tape to attach backboards to a frame structure is old (pg 2-line 3-17). The applicant also admits that the use of double sided tape was inadequate in that it was costly and time consuming (pg 2-line 9-14). A workman in the art in view of this deficiency, would have looked for other equivalent but better means of attachment in the adhesive art. The workman would have noted the art of Chung, Hankele and Skedleski et al, each of which provide similar equivalent adhesive attachment means for sporting goods. Chung discloses that the "attachment of sports articles can be secured by suitable and conventional means" which include using "silicone glue" (4:29-30). Hankele discloses the use of any of the adhesives known in the art, such as "epoxy or silicone adhesives" (2:34-37). The Skedleski et al (4792316) art discloses using a "suitable means of attachment such as silicone adhesive (1:46-49) and using a primer to improve adhesion (1:61-64). The Skedleski et al (4955314) art also discloses the desirability of the silicon adhesive having a cushioning effect (2:60-64).

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The art of Chung, Hankele and Skedleski et al clearly shows that those knowledgeable in the sporting goods adhesion art were aware of silicon adhesives and their suitability and advantages when considering cost, cushioning and superior adhesive qualities where sporting goods will be used under severe conditions, such as outdoors.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used a silicone adhesive as taught by Chung, Hankele or Skedleski et al in order to lower production costs and manufacture a more durable backboard in order to increase the player's satisfaction with the product. Also it would have been obvious to one of ordinary skill in the art to have sought and selected the most suitable adhesive from among the equivalent silicone adhesives available at the time of the invention including Dow Q3-6093 by the routine optimization expected by one of skill in the art (In re Leshin, 227 F2d197,125 USPQ 416(CCPA 1960). It should also be noted that no unexpected or extraordinary results were obtained by applicant in using the silicone adhesive. The applicant was merely following the recommended procedure for using the adhesive.

As to claims 44: See claim 1 rejection. The placement of the adhesive between the rear of the backboard and the backboard frame would naturally occur in order to hold the backboard to the frame.

As to claims 45, 47, 49, 51,53: See claim 1 rejection. Applicant's admitted prior art demonstrates that the use of acrylic for backboards is well known in the art. . It

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would have been obvious to one of ordinary skill in the art at the time of the invention to have selected any one of several equivalent materials for the backboard including acrylic based on cost, marketing and design considerations.

As to claims 46, 48, 50, 52: As well as understood, see claim 1 rejection. It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected any one of several equivalent adhesive means based on cost and design considerations. Also it would have been obvious to one of ordinary skill in the art to have sought and selected the most suitable adhesive from among the equivalent adhesives available at the time of the invention by the routine optimization expected by one of skill in the art (In re Leshin, 227 F2d197,125 USPQ 416(CCPA 1960).

As to claim 2: The use of bond gap spacers is well known in the adhesive art (No criticality is seen in the bond gap claimed. It would have been obvious to one of ordinary skill in the art of adhesives to have selected an appropriate thickness of and amount of adhesive according to manufacturer's use suggestions in order to insure the backboard remained attached during play. No extraordinary/unanticipated results are observed from using these ranges.

As to claims 5,6, 14 and 15: It not apparent that there is any criticality in the type of silicon adhesive used. It would have been obvious to one of ordinary skill in the art to have sought and selected the most suitable adhesive from among the equivalent silicone adhesives available including Dow Q3-6093 by the routine optimization

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expected by one of skill in the art. One of ordinary skill would have followed the manufacture's recommended usage and curing times to insure an adequate bond was made.

As to claim 5: Dow Corning Data sheet (Q3-6093) discloses a similar set time. Dow Corning Data sheet (Q3-6093) discloses that the working time and snap time are 15 minutes and 25 minutes respectively for a cure ratio of 10:1. The datasheet discloses the curing and set times are adjustable based on the amount of curing agent used (Fig 1-pg 2). A cure ratio of 8:1 would provide a working time and snap time of 9 and 15 minutes respectively ( $15/25=0.6$   $15*0.6=9$ ). One of ordinary skill in the art would have followed the manufacture's suggested application rules to insure a satisfactory bond.

As to claims 6 and 15: Dow Corning Data sheet (Q3-6093) discloses a similar set time. Dow Corning Data sheet (Q3-6093) discloses a set time of 15-60 minutes (Fig 1-pg 2). It would have been obvious to one of ordinary skill in the art to have followed the manufacture's suggested application directions to insure a satisfactory bond.

Claims 8-10 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1 and 14 in view of Official Notice. Official Notice was taken in the prior office action that the use of glass bead spacers is well known in the adhesive art (Spherglass webpage+ adhesion society lit review abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to have

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employed glass beads with the device in order to maintain the proper adhesive thickness in order to insure there was proper bonding between the backboard and the frame.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 in view of Official Notice. Official Notice was taken in the prior office action that the use of painted metal frames is well known in the basketball goal art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed a painted metal frame in order to provide a low cost structure that was attractive in order to increase sales.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 in view of Official Notice. Official Notice was taken in the prior office action that the use of printed images on the backboard is well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed a printed image on the backboard to insure the proper position was maintained during the bonding operation in order to reduce the number of defective and misaligned backboards and lower total production costs.

Also,

Claims 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Ichemco. Applicant has stated that the use of double sided adhesive tape to attach backboards to a frame structure is old (pg 2-line 3-17). Ichemco discloses a silicone adhesive (page 1). It would have been obvious to



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one of ordinary skill in the art to have selected any one of several equivalent adhesives, including the Ichemco silicon adhesive base on cost and design considerations. The mere selection of a well known adhesive and following the vendor's use instruction does not constitute a novel and patentable feature.

As to claim 52: See claim 50 rejection.

As to claims 51 and 53: See claim 50 rejection. Applicant's admitted prior art demonstrates that the use of acrylic for backboards is well known in the art. . It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected any one of several equivalent materials for the backboard including acrylic based on cost, marketing and design considerations.

### ***Response to Arguments***

As noted in the prior office action, the applicant has merely used an adhesive in the a manufacture's recommended way. If one were to follow the applicant's claim that this following of directions for using an adhesive now deserves a patent, to its natural end, the sales representative for the acrylic adhesive should be added to the named inventors of the application since he/she brought necessary technical knowledge for adhesives to the inventive process. There was no surprising or unexpected results found by the applicant in following the directions for using the adhesive. The use of metal backboard frame, acylic backboard and glass bead adhesive gap spacers is well known in the sport and adhesive art.

In re Sovish, Moisson, and Selleslags (CAFC 226 USPQ 771 July 26, 1985, 85-781) the court found the argument that the propriety of combining references was proper for one skilled in the art:

Appellants have argued at length about the "propriety" of "combining the two references" as though the question is simply whether the Esher patent suggests within its four corners using the disclosed tubular, closed-end plug in a heat recoverable aperture member or conduit or whether Weagant similarly suggests using art Esher type plug in place of cork-like plug 26. That is not the proper approach to the issue, which is whether the hypothetical person of ordinary skill in the relevant art, familiar with all that Esher and Weagant disclose, would have found it obvious to make a structure corresponding to what is claimed See *Kimberly-Clark Corp. vs. Johnson & Johnson*, 745 F.2d 1437, 1449, 223 USPQ 603 610 (Fed. Cir. 1984). We conclude that such hypothetical person would have found obvious what claim 1, for example, delineates, applying such "ordinary skill" as he (or she) is presumed to possess.

Finally, appellants contend that even if it were proper to "combine" the references, whatever they may mean by that, they would "neither meet the terms of the appealed claims nor result in a useful device." The question here, however is not meeting the terms of the claims. The rejection is for obviousness of what is claimed, which involves consideration of the ordinary skill of the art. As for resulting in a useful device, appellants are talking about Esher's plug not being removable and being left in the conduit which, they say, "would prevent effective heat recovery." They are assuming that one of ordinary skill would not appreciate that Esher's hollow member 14 could be removed if it is not wanted, a insulation or otherwise, and that it would not be removed by a skilled worker who wished to allow heat recovery of the conduit in which it was placed. This argument presumes stupidity rather than skill.

The decision of the board is affirmed

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is (571)272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571)272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Chambers  
Examiner  
Art Unit 3711

June 24, 2005

  
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